

REMARKS/ARGUMENTS

Claims 1-6 and 8-11 are present in this application. By this Amendment, claims 1, 4 and 8 have been amended, and claim 7 has been canceled. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

The drawings were objected to in paragraph 1 of the Office Action. Filed concurrently herewith is a Request for Approval of Drawing Corrections, eliminating the second occurrence of "32" in Fig. 5. Withdrawal of the objection is requested.

Claims 1-10 were rejected under 35 U.S.C. §112, second paragraph. The Office Action references claims 1 and 7 and contends that it is unclear if the Applicants are claiming the tool or the tool in combination with the turbine casing. Applicants respectfully submit, however, that the intended claim coverage is clear by the language of the claims and that those of ordinary skill in the art would readily understand what the Applicants are claiming. For example, claim 1 defines an alignment tool including a first section and a second section. The claim specifically recites that the first section is securable to an outer shell of a turbine casing. In a similar context, claim 1 recites that the second section is securable to an inner shell of the turbine casing. By using this word form, it would be apparent to those of ordinary skill in the art that the Applicants are claiming the tool.

Similarly, with regard to claim 7, which subject matter has been written into claim 8, the tool includes a substantially flat plate extendible across both the inner shell and the outer shell of the turbine casing. Moreover, claim 7 recites that the pair of openings through the flat plate are sized and positioned to receive the connecting bolts on the outer shell. Additionally, the plurality of apertures through the flat plate are sized and positioned to receive threaded bolts therein. Finally, a pair of planar adjusting mechanisms are respectively engageable with the connecting

bolts via the pair of openings. It is thus also clear from this language that the Applicants are claiming the tool.

Applicants thus respectfully submit that the claims satisfy the requirements of 35 U.S.C. §112, second paragraph. Withdrawal of the rejection is respectfully requested.

Claim 1 was rejected under 35 U.S.C. §102(b) over U.S. Patent No. 4,112,582 to Beckershoff. This rejection is respectfully traversed.

A feature of the present invention defined in claim 1 enables adjustment of at least one of the inner shell and the outer shell relative to the other in multiple degrees of freedom to control both co-linearity and concentricity of the outer shell and the inner shell. For clarity, claim 1 has been amended to recite that the first and second sections define structure that facilitates such adjustment. Applicants note that co-linearity and concentricity encompass at least three axes of adjustment where for example concentricity encompasses adjustment along X- and Y-axes, while co-linearity encompasses adjustment along a Z axis. Beckershoff, in contrast, only effects adjustments with regard to concentricity.

With reference to Figure 1 in Beckershoff, a key 4 includes separate portions respectively inserted into a square recess 3 and a circular recess 5. Adjustments in concentricity are made via tightening or loosening of a lock nut 9, which allows a longitudinal movement of the positioning key 4 in its housing. See column 2, line 55 - column 3, line 11. The Beckershoff construction is in fact physically unable to effect any adjustments with regard to co-linearity between the inner machine part 2 and the outer machine part 1 due at least to the arrangement of the key portions inserted into recesses 3, 5..

Applicants thus respectfully submit that the rejection is misplaced.

With regard to the Office Action's contention that claim 1 defines "intended use," Applicants respectfully submit that the definition of structure that effects adjustability to control both co-linearity and concentricity of the outer shell and the inner shell should be given patentable weight. It is well settled that "there is nothing intrinsically wrong with defining something by what it does rather than what it is in drafting patent claims." See, *In re Swinehart*, 439 F.2d 210, 212 (CCPA 1971). See also, *In re Schreiber*, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997) ("a patent applicant is free to recite features of an apparatus either structurally or functionally."). Beckershoff lacks any structure that effects adjustability to control co-linearity, and Applicants respectfully submit that claim 1 is patentable over the Beckershoff patent.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 1-3 and 7 were rejected under 35 U.S.C. §102(b) over U.S. Patent No. 4,548,546 to Lardellier. This rejection is respectfully traversed.

The Office Action does not reference any section in the Lardellier patent or any teaching thereof where an alignment tool is disclosed including structure that facilitates adjustment to control both co-linearity and concentricity. In fact, Lardellier, like the Beckershoff patent is limited only to adjustments affecting concentricity. Lardellier discloses an adjustment system for centering a turbo jet wheel within a stator ring. With reference to Fig. 2, a fixed bearing 40 is mounted within a bearing support 31 "in order to make it possible to adjust the position of shaft 24 within this support." It is clear from the figures that this structure is unable to effect adjustments pertaining to co-linearity; indeed, such adjustments are unnecessary in the Lardellier structure.

Applicants thus respectfully submit that Lardellier lacks at least the claimed structure that facilitates adjustment of at least one of the inner shell and the outer shell relative to the other in

multiple degrees of freedom to control both co-linearity and concentricity of the outer shell and the inner shell. With regard to dependent claims 2 and 3, without conceding the grounds of rejection, Applicants submit that these claims are allowable at least by virtue of their dependency on an allowable independent claim. Claim 7 has been canceled herein.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 6 was rejected under 35 U.S.C. §103(a) over Beckershoff. Without conceding this rejection, Applicants respectfully submit that Beckershoff lacks a suggestion to modify its construction to correct the deficiencies noted above with regard to independent claim 1. Applicants thus respectfully submit that claim 6 is allowable at least by virtue of its dependency on an allowable independent claim. Withdrawal of the rejection is respectfully requested.

Claim 11 was rejected under 35 U.S.C. §103(a) over Lardellier. This rejection is respectfully traversed.

As discussed above, Lardellier lacks any provision to effect adjustment relating to co-linearity. In fact, such adjustment in the Lardellier structure is neither necessary nor desirable. Under §103, teachings of references can be combined only if there is some suggestion or incentive to do so. “Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious ‘modification’ of the prior art.” *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992). The prior art must suggest the desirability of the modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). Since Lardellier is not concerned with co-linearity, Lardellier lacks even a remote suggestion that such a modification would be desirable. Applicants thus respectfully submit that the rejection of claim 11 is misplaced. Reconsideration and withdrawal of the rejection are respectfully requested.

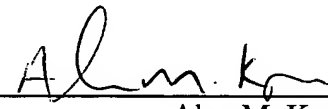
Applicants acknowledge with appreciation the indication of allowable subject matter in claims 4, 5 and 8-10. Claims 4 and 8 have been rewritten in independent form.

In view of the foregoing amendments and remarks, Applicants respectfully submit that the claims are patentable over the art of record and that the application is in condition for allowance. Should the Examiner believe that anything further is desirable in order to place the application in condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Prompt passage to issuance is earnestly solicited.

Respectfully submitted,

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